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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,714	02/27/2004	Jayasri Gunaratnam	0108-0253/US/2	6773

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RESEARCH IN MOTION, LTD
102 DECKER CT.
SUITE 180
IRVING, TX 75062

EXAMINER

CASCA, FRED A

ART UNIT	PAPER NUMBER
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2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/788,714

Applicant(s)

GUNARATNAM ET AL.

Examiner

Fred A. Casca

Art Unit

2617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See *Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-3, 5-9, 11-15, 17-19, and 24-25.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.


LESTER G. KINCAID
SENIOR PRIMARY EXAMINER

Continuation of 3. NOTE: Applicant's arguments filed on February 22, 2007 have been fully considered but they are not persuasive. Applicant's amendments to independent claims 1 and 7 adding the phrase "setting and running a periodic home network timer while operating with the communication network having the visiting MCC" were already rejected in the rejection of claims 4, 10, 13 and 19 in the previous office action.

In response to applicant's arguments that Johannesson does not disclose or suggest "the use of periodic time-triggered "scanning" step in the technique as recited in context in the independent claims" and "setting and running a periodic home network timer while operating with the communication network having the visiting MCC", the examiner respectfully disagrees and submits that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1, 181, 26 USPQ2d 1057 (Fed. Cir. 1993). Johannesson inherently discloses setting and running a periodic home network timer while operating with the second communication network (page 1, lines 28-30, "under the present standard the mobile station is required to search for the HPLMN every time the HPLMN timer expires", note that the mobile station is searching for the HPLMN network, thus it is inherent that the mobile station is in a second (non-HPLMN) communication network, outside the HPLMN network, which is inherently different than the HPLMN network. Further note that a timer or a periodic clock is inherently set and run so that it works according to the desires of the entity that sets it, e.g., it goes off at the time that it is set for by the entity. And still further note that a HPLMN timer is well known in the art to be a periodic timer (e.g., see Johannesson page 6, line 4-5, "periodically scanning for new PLMN based upon the expiration of an HPLMN timer"). Therefore, Johannesson clearly teaches setting and running a periodic home network timer while operating with the second communication network. Furthermore, Zhao clearly teaches a second communication network to be the kind of network with a Mobile Country code, MCC (Zhao, paragraph 45). Thus the combinations of Johannesson/Zhao disclose "setting and running a periodic home network timer while operating with the communication network having the visiting MCC" as claimed by the applicant.

In response to applicant's arguments that, the timer mentioned in Johannesson is not a periodic home network timer or HPLMN timer, the examiner respectfully disagrees and submits that the timer of Johannesson is clearly a periodic time that searches for a HPLMN, thus a periodic HPLMN timer (Johannesson, page 1, lines 28-30, "under the present standard the mobile station is required to search for the HPLMN every time the HPLMN timer expires").

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner disagrees with the applicant because both Johannesson and Zhao disclose communicating, roaming, and searching for at least two different communication networks. Furthermore, the combining of Zhao with Johannesson clearly teaches that the second communication network of Johannesson is provided with a MCC and a MNC as the applicant has claimed.